**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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*Ex parte* ROBERT F. LAKE Jr. and JEFFREY S. TENNANT

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Appeal 2007-0999
Application 10/600,280
Technology Center 1700

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ON BRIEF

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Before MILLS, GREEN, and LEBOVITZ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

Claims 1-24 are on appeal. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part, but designate it as a new grounds of rejection.

STATEMENT OF THE CASE

This appeal involves claims to a device and method for decontaminating a medical apparatus. Claims 1-24, all the pending claims, are on appeal (Br. 2). The claims stand finally rejected under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103(a). The following prior art references are relied upon by the Examiner as evidence:

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| Briggs | U.S. Pat. 5,641,464 | Jun. 24, 1997 |
| Sigler | U.S. Pat. 5,722,537 | Mar. 3, 1998 |

Appellants separately argue the patentability of certain claims. The claims fall into the following groups:[1] 1) claims 1, 4, 7-11, and 24; 2) claim 2; 3) claim 3; 4) claims 5 and 6; 5) claims 12-19; 6) claim 20; 7) claim 21; and 8) claims 22 and 23. We select claim 1 as representative of group 1; claim 5 of group 4; claim 12 of group 5; and claim 22 of group 8. *See* 37 C.F.R. § 41.37(c)(1)(vii). Claim 1-3, 5, 12, and 20-22 are representative as read as follows:

1. A decontamination device for decontaminating medical apparatus, comprising:
a housing;
an absorbent pad carrying a decontaminating compound placed within said housing; and
structure for removably engaging said housing to a portion of said medical apparatus,
whereby said absorbent pad is placed into contact with said portion of said medical apparatus upon engagement and removed from contact upon disengagement.

2. The decontamination device of claim 1, wherein said structure for removably engaging said housing to said medical apparatus comprises interlocking structure for engaging a portion of said medical apparatus.

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[1] 37 C.F.R. § 41.37(c)(1)(vii) states that "[c]laims argued as a group should be placed under a subheading identifying the claims by number." Because Appellants did not use subheadings when addressing the separate patentability of certain groups of claims, we designated these groups based on their arguments.

3. The decontamination device of claim 2, wherein said interlocking structure comprises at least one elastically deformable, inwardly directed protrusion on said housing.

5. The decontamination device of claim 1, further comprising additional means for attaching said housing to said medical apparatus.

12. The decontamination device of claim 1, wherein said decontaminating compound comprises a disinfecting compound and a sterilizing compound.

20. The decontamination device of claim 1, wherein said dispenser contains an indicator compound for indicating that the medical apparatus has been contacted by said decontaminating compound.

21. The decontamination device of claim 1, wherein said housing is dimensioned to receive the head of a stethoscope.

22. A method for using medical apparatus, comprising the steps of:

providing a decontamination device comprising a housing, a dispenser within said housing for contacting a portion of said medical apparatus with a decontaminating compound when said portion of said medical apparatus is placed within said housing, and structure for removably engaging said housing to said medical apparatus;

placing a portion of said medical apparatus in said housing, thereby contacting said portion with said dispenser and said decontaminating compound;

removing the portion of said medical apparatus from said housing;

using the medical apparatus in furtherance of medical procedures;

replacing the portion of the medical apparatus in the housing of the decontamination device and engaging the housing to the medical apparatus using said, [sic] engagement structure, whereby said portion of said medical apparatus is again decontaminated; and

engaging said decontamination device with said medical apparatus during the decontamination step and the medical use step.

CLAIM INTERPRETATION

*Claim 1*

The claimed decontamination device comprises three elements: 1) housing; 2) absorbent pad; and 3) "structure for removably engaging said housing to a portion of said medical apparatus." We focus our attention on the latter structure because its interpretation is at issue in this appeal.

Because the specification does not provide a definition of "removably engaging," we give the words their "ordinary and customary meaning" in the context of the specification. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005). We refer to a general purpose dictionary to determine the widely accepted meaning of the words. *See Phillips*, 415 F.3d at 1314, 75 USPQ2d at 1327. When the term "engage" is used in a mechanical context – the proper context in view of the specification – it is defined to mean "[t]o cause (gears or like) to become interlocked; interlock with."[2] The term "interlock" means "to engage or interlace one with another" and "to fit into each other."[3] The structure is for "removably engaging" the device housing to the medical apparatus. Thus, we interpret the phrase "structure for removably engaging said housing to a portion of said medical apparatus" to mean that the device housing fits into a portion of the medical apparatus. The medical apparatus is capable of being removed from, or disengaged from ("removably"), the

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[2] *The Random House Dictionary* 438 (1982).
[3] *Id.* at 695.

housing. The claim does not require the engaging structure be part of the housing.

*Claim 5*

Claim 5 further comprises "additional means for attaching said housing to said medical apparatus." The phrase "for attaching said housing to said medical apparatus" states a purpose and intended use of the attaching means, rather than conferring a definite structural limitation. Consequently, we do not interpret this phrase to further limit the attaching means.

## DISCUSSION

*Rejection under 35 U.S.C. § 112, second paragraph*

The basis of the rejection is an obvious typographical error that Appellants attempted to correct in an un-entered amendment filed after the Final Rejection (Amendment filed Nov. 16, 2005). Appellants did not otherwise address this rejection in their Brief. Accordingly, we affirm it.

*Rejection under 35 U.S.C. § 103(a)*

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as obvious over Sigler in view of Briggs.

Sigler teaches a portable half-oval shaped disinfectant container for an infant pacifier or nursing nipple (Abstract). The disinfectant container comprises an absorptive sponge that is shaped to fit inside the lower part of the container (Col. 1, ll. 59-61). The sponge may be saturated with a sterilizing or non-toxic disinfectant solution (Abstract; Col. 3, ll. 8-10). The sponge contains an opening slit cut into its central area to receive the pacifier

or nursing nipple (Col. 3, ll. 1-7). To accomplish sterilization, the pacifier (or nipple) is inserted into the opening of the disinfectant-filled sponge which places the pacifier in contact with the disinfectant solution (Col. 2, l. 6-13; Col. 3, ll. 5-7 and 60-65; Col. 4, ll. 36-39). The container can also have "an attached hook for hanging on a purse, baby bag, stroller, or crib." (Abstract.)

Briggs describes a device for cleansing a stethoscope head with an antimicrobial spray liquid (Abstract). "The device includes a housing which defines a generally central cavity in which an aerosol spray cannister [sic] is releasably disposed in a bracket. The housing is closed but is openable in order to replace the cannister [sic], as needed." (*Id.*) The housing includes an openable port, such as a "flexible resilient closeable X-shaped or iris-shaped diaphragm" through which the head of a stethoscope is inserted for cleansing in the cavity." (Col. 3, ll. 30-35.) When the stethoscope head is inserted into the port, "diaphragm 60 closes around tube 28 of stethoscope 58, sealing plate 40 from egress of aerosol spray from cannister [sic] 15." (*Id.*)

The Examiner asserts:

> It would have been well within the purview of one of ordinary skill in the art to configure the device of Sigler for access to the absorbent, with the engagement structure as taught [i]n Briggs, [sic] III, such as to accommodate the head of a stethoscope for disinfection because it would provide an effective, compact, portable system which be carried with the stethoscope user for immediate, on-site disinfection between uses while eliminating the need for a potentially flammable propellant, minimizing the probability of spillage and user contact with the decontaminating agent by containment within the absorbent pad in the housing. (Answer 4-5.)

Appellants contend that neither Briggs nor Sigler describe "engaging" an apparatus as required by claim 1 (*See* Br. 7 and 14). They argue:

> Briggs cannot engage the stethoscope as required by Applicants' claims. The term "flexible" by definition requires yielding. A yielding structure cannot engage a device against motion. Should the diaphragm 60 of Briggs be of a sufficient rigidity that it would engage the housing and the medical apparatus, it would not flexibly seal around the tube 28 of stethoscope 58, as intended by Briggs, to guard against the egress of aerosol spray. The provision of the open port 25 with no engagement structure at its edge would also serve to prevent engagement with the stethoscope.

(Br. 7.)

*Claims 1, 4, 7-11, and 24*

After reviewing both references, we find that the "slit" in Sigler's sponge for accommodating a pacifier meets the limitation in claim 1 of a structure for "removably engaging." When the pacifier is pushed into the sponge slit, the sponge material fits around it, locking it into place. This conclusion is consistent with the specification which lists a "slot" as a suitable structure for engaging a portion of a medical apparatus (Specification [0025]). A synonym for "slot" is "slit."[4] Because Sigler's slit meets the requirement of claim 1 for a "removably engaging" structure, it is unnecessary to address Appellants' arguments regarding Briggs' diaphragm. Moreover, with respect to claim 1 only in this grouping, we find that all other limitations of the claim are met by Sigler. Consequently for claim 1, we affirm the rejection, but designate it as a new ground of rejection under

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[4] Slot: "narrow, elongated depression, groove, notch, slit, or aperture. *Id.* at 1239

35 U.S.C. § 102(b) over Sigler alone because Briggs is unnecessary to reach all the limitations of the claims.

Appellants state that Sigler discloses a process in which the pacifier is moved around in the sponge slit and thus does not positively engage it (Br. 14). However, we see nothing in the claim language which would restrict the mobility of the apparatus, once inserted into the container. We remind Appellants that claims are given their broadest reasonable interpretation during patent prosecution. "Construing claims broadly during prosecution is not unfair to the applicant . . . , because the applicant has the opportunity to amend the claims to obtain more precise claim coverage." *In re Am. Acad. Sci. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, 70 U.S.P.Q.2d 1827, 1830 (Fed. Cir. 2004). Appellant has not explained why the skilled worker, in view of the specification, would have interpreted "removably engaging" so restrictively.

For claims 4, 7-11, and 24, which were not separately argued, we find that the combination of Sigler in view of Briggs is proper, and affirm the rejection under § 103. However, we designate the rejection of claims 4, 7-11, and 24 as a new ground of rejection because of their dependence on claim 1.

With regard to the rejection of claims 4, 7-11, and 24 over the combination of Sigler in view of Briggs, we do not find Appellants' argument persuasive that Sigler is non-analogous art (Br. 8-9). Even when the prior art is not within the same field of endeavor, a reference may be still properly combined when pertinent to the problem an inventor seeks to solve. *In re Clay*, 966 F.2d 656, 658-9, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *Clay*, 966 F.2d at 659, 23 USPQ2d at 1061. In this case, Sigler addresses a similar problem to the one confronted by Appellants: to sterilize the surface of a device in contact with a human body. Consequently, we find it reasonably pertinent to Appellants' field of endeavor.

*Claim 2*

Claim 2 recites that the "structure" of claim 1 comprises an "interlocking structure for engaging a portion of said medical apparatus." Appellants separately argued this claim, asserting that the "interlocking structure securely retains the medical device, which the Briggs device would not." (Br. 7.)

We find that the Sigler's sponge slit would act as an "interlocking structure for engaging a portion of aid medical device" because the pacifier nipple would fit into the sponge slit.[5] Accordingly, we affirm the rejection, but designate it as a new ground of rejection under 35 U.S.C. §102(b) over Sigler alone.

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[5] Appellants argue that "engaging" means "interlock." (Br. 11.) As we have adopted this definition, it is not clear how claim 2 further limits claim 1.

*Claim 3*

Claim 3 further requires that "said interlocking structure comprises at least one elastically deformable, inwardly directed protrusion on said housing."

The Examiner asserts that Briggs "clearly teaches an iris structure that interlockingly engages the medical apparatus by elastically deforming inwardly." (Answer 5.)

We agree with Appellants that there would have been no motivation to have modified Sigler's interlocking slit with Briggs' teaching of an iris structure for engaging a medical apparatus. Sigler's disinfectant container works by inserting the pacifier nipple into the sponge. It sterilizes the pacifier by requiring the user to move it "up and down," "sideways," or "circular" within the slit (Col. 2, ll. 6-13). The "engaging" slit is therefore integral to the Sigler's disinfectant container, it being the structure necessary for the container to achieve its purpose in disinfecting a pacifier. Because Sigler's slit serves as the structure for engaging, there would have been no motivation to have utilized another engaging structure, such as the iris-shaped structure of Briggs. It would be redundant. The Examiner's position is deficient because it does not explain what would have motivated the skilled worker to have substituted Sigler's slitted sponge with Briggs's iris in a decontamination device.

Because we have found no motivation to have utilized Brigg's iris on Sigler's disinfectant container for a pacifier, we reverse this rejection.

*Claims 5 and 6*

Claim 5 further requires the device to comprise "additional means for attaching" the housing to the medical device.

The Examiner asserts that the hook attached to Sigler's disinfectant container "is fully capable of functioning as recited in apparatus claims 5 and 6." (Answer 7.) Appellants contend that the claimed attaching structure is advantageous because enables it to be attached to the medical device when in use (Br. 8, 10). We find that the Examiner has the better argument. As discussed *supra*, we do not interpret the phrase "for attaching said housing to said medical apparatus" to confer a structural limitation to the attaching means. Appellants' arguments relate to the convenience of the attaching means when the device is in use; they do not distinguish the structure, itself, from the structure described by Sigler. Accordingly, we affirm the rejection, but designate it as a new ground under 35 U.S.C. § 102(b) over Sigler alone for the reasons articulated *supra* on p. 7 for claim 1.

*Claims 12-19*

Claims 12-19 are directed to particular decontaminating compounds in combination with an absorbent pad that is engaged to the device (Br. 8). The Examiner asserts that both Briggs and Sigler teach that any known sterilizing/disinfecting agent is acceptable for use in their devices (Answer 5). Appellants do not rebut the Examiner's findings, but only argue that "Briggs does not have an absorbent pad." (Br. 8.)

We find the Examiner's rejection to be reasonable and supported by the evidence. Accordingly, we affirm the rejection of claims 12-19 under

§ 103, but because the claims depend on claim 1, we designate it as a new ground of rejection.

*Claim 20*

Claims 20 further comprises "an indicator compound for indicating that the medical apparatus has been contacted by said decontaminating compound." The Examiner argues that

> it would have been well within the purview of one of ordinary skill in the art to include indicator means identifying whether or not the disinfectant had contacted the stethoscope to assure the user that disinfection had occurred, and that disinfectant was still available for use, the conventionality of such is well recognized as evidenced by the use of iodine or betadine compounds which leave residual coloration identifying use.

(Answer 5-6.)

Appellants assert that neither Briggs nor Sigler describes the advantage of an indicator compound (Br. 13), but do not address the Examiner's assertion that a conventional disinfectant, such as iodine or betadine, would leave a color residue after use, inherently fulfilling the claimed requirement. Because we find the Examiner's position reasonable, and because Appellants did not provide arguments to rebut it, we affirm the rejection of claim 20. Accordingly, we affirm the rejection of claim 20 under § 103, but because it depends on claim 1, we designate it as a new ground of rejection.

*Claim 21*

Claim 21 recites that the "housing is dimensional to receive the head of the stethoscope." Appellants argue that claim 21 "points out the need for

a positive engagement of a stethoscope head within the housing to force it into engagement with the absorbent pad." (Br. 13.)

However, in Sigler's disinfectant container, a pacifier is "pushed" into the slit, making contact between the pacifier and sponge surfaces (Col. 3, ll. 4-7). We think it is reasonable that the slit could accommodate at least a portion of the stethoscope head, meeting the claim limitation. Appellants' argument that Sigler and Briggs only describe placing the item "loosely" in the decontamination chamber is not persuasive because the "removably engaging" is not so limited. Accordingly, we affirm the rejection, but designate it as a new ground of rejection under 35 U.S.C. §102(b) over Sigler alone because Briggs is unnecessary to reach all the limitations of the claims.

*Claims 22 and 23*

Claims 22 is a method claim. Appellants' arguments for these claims are the same as those addressed already for claim 1. Accordingly, for the reasons set forth *supra*, we affirm the rejection of claims 22 and 23, but designate it as a new ground of rejection under 35 U.S.C. §102(b) over Sigler alone because Briggs is unnecessary to reach all the limitations of the claims.

## SUMMARY

We affirm the rejections of claims 1, 2, and 4-24, but designate them as new grounds of rejection under 37 C.F.R. § 41.50(b) because our reasoning differs from the Examiner's. We reverse the rejection of claim 3.

## TIME PERIOD

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellants elect to prosecute further before the examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection,

the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRM-IN-PART /§ 41.50(b)

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